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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/575,710

Filing Date: July 25, 2000

Appellant(s): MOTOYAMA ET AL.

Kurt M. Berger

For Appellant

Examiner's Answer

This is in response to the appeal brief filed 10/03/2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal:

Motoyama (US 5,887,216) issued on 03/23/1999.

Hummel, Jr. et al. (US 6,584,454) issued on 06/24/2003.

Othmer et al. (US 6,167,358) issued on 12/26/2000.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-4, 6-8, 11, 13-14, 16-18, 21, 23-24, 26-28 and 31-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama (US 5,887,216), in view of Hummel, Jr. et al. (US 6,584,454), herein after referred as Hummel.

3. As to claim 1, **Motoyama** teaches a system, comprising:

a receiver configured to receive the at least one of the device state and the device event of the remotely monitored device (the monitoring device receives image density information from the monitored device) (**Motoyama, C10: L9-14**);

a digital storage system configured to maintain a history of the at least one of the device state and the device event of the remotely monitored device, and a service history of the remotely monitored device (database describes various information of the

monitored device/machine such as service history, optional equipment, usage information, or other information as in information field 476 describing malfunctions, and other special conditions/events) (Motoyama, Figs. 9A-9C; C10: L4-7 and L35-55); and

an analyzer configured to analyze the service history and the at least one of the device state and the device event of the remotely monitored device to determine a service request to be performed on the remotely monitored device (*in step 410 of Fig. 8, the monitoring device analyzes the received image density information, by comparing the received image density information with information looked up in the database, wherein the database describes various information of the remotely monitored device or machine such as service history, optional equipment, usage information, or other information as in information field 476 describing malfunctions, and other special conditions/events and determines that it is appropriate to change the parameters of the remotely monitored device*) (Motoyama, Fig. 8, C10: L4-7 and L14-18).

However, **Motoyama** does not explicitly teach a service depot comprising a computer configured to receive the service request from the analyzer over a Wide Area Network (WAN), to analyze the service request, and to contact a user of the remotely monitored device regarding the service request, wherein the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device.

In a related art, **Hummel** teaches a service depot comprising a computer configured to receive service request from the analyzer over a Wide Area Network "WAN" (*i.e., the management station 70 which will typically include a monitor 74 for viewing system operation parameters, analyzing system utilization, and exchanging*

service requests and data between the remote facility 20 and the central service facility 22 via a remote access network 80 such as the Internet) (Hummel, Fig. 1, C5: L47-51), to analyze the service request, and to contact a user of the remotely monitored device regarding the service request, wherein the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device (the service facility 22 also includes a bank of operator workstations 86, which maybe staffed by service engineers who address/analyze the service requests and provide off- and on-line service to the diagnostic systems in response to the service requests) (Hummel, Fig. 1 and C6: L24-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of **Motoyama** and **Hummel** to have the service requests being sent to a service depot, where the service request is analyzed, and then sent to a user of the remotely monitored device because it would allow the service depot (*i.e., allow the remote central service facility 22 staffed by service engineers*) efficiently to address the service requests by providing off-line and on-line services to the remote monitored devices in response to the service requests (*i.e., by providing centralized service to a plurality of remotely located devices*) (Hummel, C4: L31-33 and C6: L24-28).

4. As to claim 3, **Motoyama-Hummel** teaches the system of claim 1, wherein the Wide Area Network comprises the Internet (*linked to the central service facility 22 via a remote access TCP/IP network 80, Web server, etc.*) (Hummel, C5:L64 – C6: L12).

5. As to claim 4, **Motoyama-Hummel** teaches the system of claim 1, further comprising a transmitter configured to transmit the service history to the service depot *(the processing system 84 within the service facility 22 maybe linked to a system of databases including extensive database information on operating parameters, service histories, etc. that maybe employed/accessed by the service facility 22 for servicing of particular diagnostic systems and for tracking such servicing)* (**Hummel, C6: L28-38**).

6. As to claim 6, **Motoyama-Hummel** teaches the system of claim 1, wherein the receiver comprises a configuration receiver configured to obtain information from the device over a Wide Area Network *(i.e., data maybe exchanged over a remote access TCP/IP network 80, the Internet)* (**Hummel, C5:L64 – C6: L12**).

7. As to claims 7-8, **Motoyama-Hummel** teaches the system of claim 1, wherein the device comprising a business office machine, such as a copier, a printer, a fax, a scanner, or a thin server *(the monitored devices can be a remote digital copier, facsimile machine, or printer)* (**Motoyama, Fig. 1 and C4: L27-31**).

8. As per claims 31 and 34-35, **Motoyama-Hummel** teaches the system of claim 1, wherein the computer is configured to contact the user of the remotely monitored device by telephone or through an electronic mail message (WAN) *(i.e., the business office device communicates with a diagnostic service center via a connectionless-mode of communication such as by an Internet electronic mail message)* (**Motoyama, Abstract**).

9. Claims 11, 13-14, 16-18, 32 and 36-37 are corresponding computer program claims of system claims 1, 3-4, 6-8, 31 and 34-35; therefore, they are rejected under the same rationale.

10. Claims 21, 23-24, 26-28, 33 and 38-39 are corresponding computer-implemented method claims of system claims 1, 3-4, 6-8, 31 and 34-35; therefore, they are rejected under the same rationale.

11. Claims 9-10, 19-20, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Motoyama-Hummel**, and further in view of **Othmer et al.** (US 6,167,358), herein after referred as **Othmer**.

12. As to claims 9-10, **Motoyama-Hummel** teaches the system of claims 1, but does not explicitly teach the remotely monitored device comprising a mobile unit such as an automobile, a boat, a train or an airplane.

In a related art, **Othmer** teaches a system and method for remotely monitoring a software application or a microprocessor on a distributed set of client computers or machines including automobiles (**Othmer, C4: L26-35**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include monitoring automobiles, as taught by **Othmer**, in the modified **Motoyama-Hummel** invention because monitoring such machines would allow for the detection of defects and malfunctions (**Othmer, C4: L19-35**).

13. Claims 19-20 are corresponding computer program claims of system claims 9-10; therefore, they are rejected under the same rationale.

14. Claims 29-30 are corresponding computer-implemented method claims of system claims 9-10; therefore, they are rejected under the same rationale.

(10) Response to Argument

In the Argument, applicant argued in substance that

(A) Prior Arts fail to disclose *"an analyzer configured to analyze the service history and the at least one of the device state and the device event of the remotely monitored device to determine a service request to be performed on the remotely monitored device"*, as claimed in claim 1.

As to point (A), before addressing the argument, Examiner submits that the language of the limitation cited in the quotation *"the at least one of the device state and the device event of the remotely monitored device"* can be given broad and reasonable interpreted in light of specification as the received image density information of the remotely monitored device.

Motoyama teaches in step 410 of Fig. 8, the monitoring device analyzes the received image density information by comparing the received image density information with "information" looked up in a database, wherein the database describes various information of the monitored device or machine such as service history, optional equipment, usage information, or other information (**Motoyama, C10: L4-7**) and determines that it is appropriate to change the parameters of the remotely monitored device (*i.e., comparing/analyzing the at least one of the device state and the device event of the remotely monitored device and the service history to determine a service request to be performed on the remotely monitored device*) (**Motoyama, Fig. 8 and C10: L14-21**).

(B) Applicant argued that the Office Action has failed to provide technological motivation for one of ordinary skill in the art to combine the teachings of the '216 (**Motoyama**) and '454 (**Hummel**) patents.

As to point (B), in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, **Motoyama** substantially teaches the invention as claimed but does not explicitly teach a service depot comprising a computer configured to receive the service request from the analyzer over a Wide Area Network (WAN), to analyze the service request, and to contact a user of the remotely monitored device regarding the service request, wherein the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device.

In a related art, **Hummel** teaches a service depot comprising a computer configured to receive service request from the analyzer over a Wide Area Network "WAN" (i.e., the management station 70 which will typically include a monitor 74 for viewing system operation parameters, analyzing system utilization, and exchanging service requests and data between the remote facility 20 and the central service facility 22 via a remote access network 80 such as the Internet) (**Hummel, C5: L47-51**), to analyze the service request, and to contact a user of the remotely monitored device regarding the service request, wherein the service depot is configured to provide preventive and reparative maintenance to the remotely monitored device (the service facility 22 also includes a bank of operator workstations 86, which maybe staffed by service engineers who address/analyze the service requests and provide off- and on-line service to the diagnostic systems in response to the service requests) (**Hummel, Fig. 1 and C6: L24-28**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of **Motoyama** and **Hummel** to have the service requests being sent to a service depot, where the service request is analyzed,

and then sent to a user of the remotely monitored device because it would allow the service depot (*i.e., allow the remote central service facility 22 staffed by service engineers*) efficiently to address the service requests by providing off-line and on-line services to the remote monitored devices in response to the service requests (*i.e., by providing centralized service to a plurality of remotely located devices*) (Hummel, C4: L31-33 and C6: L24-28).

For the above reasons, it is believed that the rejections should be sustained.

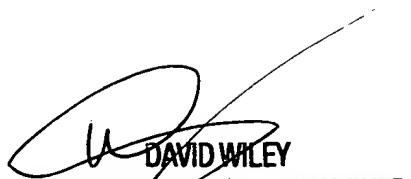
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,
Q.N.N.
Quang N. Nguyen

Conferees,


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